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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,253	06/07/2000	Kerimcan Engin	3212/3	8672

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,253

Applicant(s)

ENGIN ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to communication dated February 11, 2003. Claims 1-10 and 18 have been canceled as requested by the applicants. Amended claims 11, 15 and 19 and new claims 21-24 have been entered. Claims 11-17 and 19-24 have been examined. The restrictions, rejections and response to arguments are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 11-17, 19 and 20 drawn to a system and method for providing investment advice to investors over a computer network, comprising receiving investment strategies and trade recommendations from investment advisors, allowing the investor to accept, reject, or modify each of the trade recommendations, permitting the investor to enter one or more investor trade recommendations based on an investor-defined strategy and submitting trade recommendations for execution, classified in class 705, subclass 36.

II. New claims 21-24, drawn to a system for brokering financial investment advice, comprising means for receiving and storing investment strategies and a sequence of trade recommendations from investment advisors, specifying and applying management weights assigned to subscribed investment strategies, submitting trade recommendations for execution and updating the holdings information in the investor portfolio, classified in class 705, subclass 36.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the steps of specifying and applying management weights

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assigned to subscribed investment strategies, updating the holdings information in the investor portfolio present in invention II are not present in invention I, clearly indicating that the method and utility of the two inventions are different. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is different from that required for Group II, restriction for examination purposes as indicated is proper.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US Patent 6018722) in view of Beaulieu et al (US Patent 5502637) and further in view of O'Shaughnessy (US Patent 6484151 B1).

With reference to claim 11, Ray teaches a system for providing investment advice to investors over a computer network, comprising means for permitting the investor to enter one or more investor trade recommendations based on an investor-defined strategy and means for submitting trade recommendations to a brokerage account for execution. (See Ray Claim 5)

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Ray does not explicitly teach the means for receiving a plurality of investment strategies from a plurality of investment advisors and the means for allowing an investor to subscribe to at least one of the investment strategies.

Beaulieu teaches the means for receiving a plurality of investment research from a plurality of investment advisors (See Beaulieu Column 3 lines 24-27) and the means for allowing an investor to subscribe to at least one of the investment strategies (See Beaulieu Column 3 lines 30-34). The investment research is interpreted to include investment strategies including a plurality of trade recommendations and the entitlement lists imply investor subscribing to at least one of the investment strategies.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Beaulieu to the invention of Ray. The combination of the disclosures taken as a whole, suggests that investors would have benefited from having the option of choosing from several investment strategies in one shot without having to subscribe to each of them separately thereby saving time and expenses. The investment advisors would benefit from the fact that only authorized subscribers are getting their recommendations.

Both Beaulieu and Ray combined fail to explicitly teach the means for allowing the investor to accept, reject, or modify each of the trade recommendations of the at least one investment strategy to produce a sequence of customized trade recommendations.

O'Shaughnessy teaches the means for allowing the investor to accept, reject, or modify each of the trade recommendations of the at least one investment strategy to produce a sequence of customized trade recommendations (See O'Shaughnessy Column 3 lines 4-23).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by O'Shaughnessy and Beaulieu to the invention of Ray. The combination of the disclosures taken as a whole, suggests that investors would have further benefited from having the option to accept, reject, or modify each of the trade recommendations and thereby create their own strategy that in their opinion would be the best for their needs and circumstances.

With reference to claim 12, Ray teaches a system of claim 11, wherein the at least one of the advisory strategies includes investment preferences and other information (See Ray Column 5 lines 1-29) Investment preferences and other information are interpreted to include at least one parameter selected from the group consisting of an initial investment amount, a recommended minimum investment, a tradable financial instrument set allowed position types, and restrictions on cash transactions.

With reference to claim 13, Ray teaches a system of claim 11, further comprising means for executing a plurality of trade transactions based on the trade recommendations (See Ray Claim 1 and Column 10 lines 13-16).

With reference to claim 14, Ray teaches a system of claim 11, further comprising means for updating the advisor strategies at predetermined intervals (See Ray Column 9 lines 1-8). Once daily is interpreted to include predetermined intervals.

6. Claims 15-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US Patent 6018722) in view of Beaulieu et al (US Patent 5502637).

With reference to claim 15, Ray teaches a method of providing investment advice to an investor, comprising assigning a risk/return measure to each of investment strategies, providing a

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search utility that permits the investor to select at least one of the investment strategies based on a risk measure, and maintaining a portfolio for the investor, the portfolio defining a plurality of customized trade recommendations. (See Ray Claims 1 and 5)

Ray does not explicitly teach the steps of receiving a plurality of investment strategies from a plurality of investment advisors and using a strategy client database to maintain a subscription to one or more of the investment strategies for the investor.

Beaulieu teaches the steps of receiving a plurality of investment reports from a plurality of investment advisors (See Beaulieu Column 3 lines 24-27) and using a strategy client database to maintain a subscription to one or more of the investment strategies for the investor (See Beaulieu Column 3 lines 30-34). The investment research is interpreted to include investment strategies including a plurality of trade recommendations and the entitlement lists imply a strategy client database to maintain a subscription to one or more of the investment strategies for the investor.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Beaulieu to the invention of Ray. The combination of the disclosures taken as a whole, suggests that investors would have benefited from having the option of choosing from several investment strategies in one shot without having to subscribe to each of them separately thereby saving time and expenses. The investment advisors would benefit from the fact that only authorized subscribers are getting their recommendations.

With reference to claim 16, Ray teaches a method of claim 15, further comprising providing the plurality of trade recommendations to a brokerage account (See Ray Column 9 line 65 – Column 10 line 16).

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With reference to claim 17, Ray teaches a method of claim 16, further comprising executing a plurality of trades based on the trade recommendations. (See Ray Column 10 lines 13-16).

With reference to claim 19, Ray teaches a method of claim ¹⁵~~18~~, further comprising updating the strategy trade recommendations at predetermined intervals (See Ray Column 9 lines 1-8). Once daily is interpreted to include predetermined intervals.

With reference to claim 20, Ray teaches a method of claim 15, further comprising synchronizing information contained in the portfolio with a brokerage account (See Ray Claim 9).

Response to Arguments

7. Applicant's arguments with respect to claims 11-17, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
April 12, 2003

Richard Weisberger
Primary Examiner